

Application No.: 10/784398

Case No.: 59555US002

REMARKS

Claims 1 to 23 are pending. Claims 1 to 17 have been withdrawn from consideration.
Claim 18 has been amended.

Restriction Requirement

The Office action essentially states:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to an aqueous composition, classified in class 252, subclass varies.

II. Claims 7-9, drawn to a flexible circuit, classified in class 425, subclass 436R.

III. Claims 10-17, drawn to a process for etching a polycarbonate film, classified in class 216, subclass 56.

IV. Claims 18-23, drawn to a dielectric film, classified in class 428, subclass 412.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a different process such as by acid etching or by surface ablation. The process as claimed can be used to make a different product such as a decorative artwork.

3. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are an etchant composition and a polymeric film.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Atty:Melanie Gover on November 10, 2004 a provisional election was made with traverse to prosecute the invention of group IV, claims 18-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicants affirm the election with traverse.

§ 102 Rejections

Claims 18-20 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Klun et al (US 5227008).

The Office Action essentially states that:

Klun discloses a flexible circuit board comprised of a polymeric film and a photoresist mask (col 2 L 21-26).

The polymeric film can be a polycarbonate film (col 2 L 49-51). The polymeric film has a thickness from about 12-125 μm (col 4 L 37-39).

The polymeric film is etched to obtain a reduced thickness, the etchant used is a basic solution (col 3 L 41-43 & L 33-35).

The final thickness of the polymeric film can be determined or controlled by the concentration of the etchant and the amount of time for etching (col 3 L 55-57). Since the polymeric film can be as thin as 12 μm initially, it would have been obvious that after etching its thickness would be less than 12 μm .

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Applicants respectfully submit that according to MPEP 2131 "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (citing *Verdegall Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants have amended claim 18 to include the limitation that the article is a carrier pocket tape. This amendment is supported by the specification, e.g., p. 8, line 12. Klun does not disclose carrier pocket tape. Accordingly, the reference does not describe every element of the claimed invention.

Based on the foregoing, Applicant(s) submit that the cited reference cannot support a 35 U.S.C. 102(b) rejection and respectfully requests that the rejection be withdrawn.

§ 103 Rejections

Claims 18-23 stand rejected under 35 USC § 103(a) as being unpatentable over Klun et al (US 5227008).

The Office Action essentially states that:

Klun teaches the present invention but is silent about having a plurality of recesses. Also, Klun is silent about having another polycarbonate film or a thermoplastic film laminated to the polycarbonate film.

In view of Klun's method, one skill in the art would choose the same etchant to selectively etch the polymeric (or polycarbonate) film to obtain a multiple recesses surface because it is matter of design choice. Furthermore, it is also obvious to laminate a second polycarbonate or thermoplastic film because it protects the thin polycarbonate film.

Applicants respectfully submit that according to MPEP 2142, to establish a case of prima facie obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

Applicants have amended claim 18 to include the limitation that the article is a carrier pocket tape.

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Applicants respectfully submit that the references cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited reference does not provide a motivation or suggest for making a carrier pocket tape because Klun teaches how to make a flexible circuit. In addition, Klun does not disclose all the elements of the present invention because it does not disclose a carrier pocket tape.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 102 and 103 is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant(s)' attorney if the Examiner believes any remaining questions or issues could be resolved.

Respectfully submitted,

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Date

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